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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/575,321

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Marc Chilla

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E. I. DuPont Nemours and Company
4417 Lancaster Pike
Wilmington, DE 19805

EXAMINER

FLETCHER III, WILLIAM P

ART UNIT

PAPER NUMBER

1715

MAIL DATE

DELIVERY MODE

12/17/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/575,321	Applicant(s) CHILLA ET AL.	
	Examiner William P. Fletcher III	Art Unit 1715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/28/2010 has been entered.

Response to Amendment

2. Claims 1-9 remain pending.

Response to Arguments

3. Upon further consideration of Schlaak, the Primary Examiner withdraws the rejections set forth in the prior Office action, but not for all of the reasons Applicant argued.

4. The Primary Examiner reminds Applicant that “[t]he inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness.” See *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995). MPEP § 2112.01(I) states, regarding chemical compositions: “Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. ...’Products of identical chemical composition cannot have mutually exclusive properties.’ A chemical

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composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)." Applicant properly bears the burden of rebuttal.

5. Applicant amended claim 1 to recite, vis-à-vis the process steps, the transitional phrase *consisting essentially of*. MPEP § 2111.03 states, regarding transitional phrases: "The transitional phrase 'consisting essentially of' limits the scope of a claim to the specified materials or steps 'and those that do not materially affect the basic and novel characteristic(s) of the claimed invention.' *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976)." Applicant did not identify what basic and novel characteristic(s) of the invention, if any, are affected by which additional steps of the cited prior art, if any. Concerning such a situation, the MPEP further states: "If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of 'consisting essentially of,' applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964)."

6. Applicant argued that since, according to Schlaak, both layers contain polyurethane (PU), both layers contain an admixture component and, consequently, fail to satisfy the claims which require the first layer to be *modified* (i.e., including an admixture component) and the second layer to be *unmodified* (i.e., excluding an admixture component). The Primary Examiner disagrees. The PU is actually Schlaak's preferred binder resin and not an admixture component. See 3:40-8:12. Further, within

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the context of the invention, one may not unambiguously characterize PU as an admixture component, since the instant specification characterizes PU as a binder [8:20+] and urethane resin as an admixture component [13:top]. Consequently, stating that Schlaak's PU resin is an admixture component but not a binder is an arbitrary characterization and does not persuasively weigh against the *prima facie* case of record. Nevertheless, a more thorough review of Schlaak's disclosure reveals that, in Schlaak's preferred embodiment: "[i]t is preferable that the first and second water-based base lacquer, apart from the excess polyurethane in the first water-based lacquer, have qualitatively the same resin composition, i.e. the same binder and optional cross-linking agent and optional paste resins. ...In particular it is preferred that the two water-based base lacquers do not differ with regard to their qualitative or quantitative solid resin composition with the exception of the differentiation criterion which is an essential part of the invention [i.e., excess PU in the first lacquer]" [7:25-29 and 34-39]. Consequently, it would be directly contrary to the preferred embodiment of Schlaak to formulate one lacquer to have a component that the second lacquer does not. The Primary Examiner acknowledges that this is merely a preferred embodiment, and that "[d]isclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure of non-preferred embodiments" (MPEP § 2123(II)), but Schlaak and the rest of the prior art is silent as to a teaching, suggestion, or motivation for formulating the compositions in this fashion. Consequently, Schlaak is removed as a reference against the claims.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Applicant amended claim 1 to recite the phrase *having problematic color shades* which is indefinite since the record does not contain a definition of the term from which one skilled in the art may understand the metes and bounds of the phrase. The Primary Examiner identifies 2:21-3:8 of the instant specification as providing the best description of the phrase. Yet this disclosure is riddled with relative terms (e.g., *large quantities*, *small amounts*) and indefinite language (e.g., *may penetrate*, *for example*, *should*) from which no meaningful, clear, and unambiguous definition may be divined. A description along the lines of that at 19:20+ of the specification in co-pending 11/1565,808 would be an example of such language.

Allowable Subject Matter

10. Claims 1-9 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

11. The following is a statement of reasons for the indication of allowable subject matter: The prior art neither teaches nor suggests the claimed process *wherein the first layer comprises a modified water-borne base coat produced by mixing an unmodified water-borne base coat with an admixture component and the second layer comprises the unmodified water-borne base coat.*

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William Phillip Fletcher III/
Primary Examiner, Art Unit 1715

15 December 2010